

31. (New) A composition comprising:

at least one linear dimethicone in an amount ranging from 25% to 75% by weight relative to the total weight of the composition; and

at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, with the proviso that said composition comprises at least one tri-block copolymer film former.

RH
Con

REMARKS

I. Status of the Claims

Claims 1, 2, and 4-31 are pending in this application. Applicants acknowledge and thank the Examiner for the withdrawal of the objection to claim 25, the rejections under 35 U.S.C. § 112, second paragraph, the rejections under 35 U.S.C. §§ 102(b) and 103(a) over *Reusch* and *Curtis*, and the rejections under 35 U.S.C. § 102 over *Konik*, and over *Anton*.

The specification at page 9, last paragraph, and claims 1 and 10 have been amended to recite that the concentration of the at least one block copolymer film former ranges from 0.139% to 4.185% by weight, such as from 0.265% to 1.953% by weight. It was recognized that the concentrations recited at page 9, last paragraph, and claim 10 reflected the concentration of the commercially available mixture, Versagel M5960. Thus, although this error was corrected in the table of

Example 1 in their Amendment filed September 28, 2002, the same error at page 9, last paragraph, and in claim 10 were erroneously not amended at that time. The error was made in calculating the amount of at least one block copolymer film former that was used in each of the formulations disclosed in the specification. Specifically, in calculating the weight percent of each ingredient based on the examples performed by Applicants, it was assumed that all of the ingredients were sold as 100% active ingredient. However, Versagel M5960 comprises about 86.03% by weight isododecane. Accordingly, the total amount of block copolymer film formers in Versagel M5960 is about 13.95% by weight of the Versagel M5960. As a result, the application as filed contained the obvious error of equating, e.g., 2% by weight of Versagel M5960 to 2% by weight at least one block copolymer film former when in actuality, 2% by weight of Versagel M5960 equals 0.279% by weight ($0.02 \times 13.95\%$) of at least one block copolymer film former. Accordingly, 1% by weight Versagel equals 0.139% by weight at least one block copolymer film former; 30% by weight Versagel equals 4.185% by weight at least one block copolymer film former; 1.9% by weight Versagel equals 0.265% by weight at least one block copolymer film former; and 14% by weight Versagel equals 1.953% by weight at least one block copolymer film former.

The error was quickly recognized when one skilled in the art tried to calculate concentration ranges using the examples. The skilled artisan not only recognized the error in the percent active ingredient of at least one block copolymer film former

but also recognized the appropriate correction needed in order to calculate the correct concentration of at least one block copolymer film former present in the invention. This falls squarely within the requirements of M.P.E.P. §2163.07, which states that an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the errors in the specification, but would also recognize the appropriate correction. See In re Oda, 443 F.2d 1200, 170 U.S.P.Q. 260 (CCPA 1971).

Further, the amendments to the specification and claims to correct the error made in calculating the amount of at least one block copolymer film former clarify that the concentrations of the at least one block copolymer film former are disclosed as amounts of active material. Thus, one of ordinary skill in the art could readily calculate the amount of active material in the at least one block copolymer film former formulation of choice (as disclosed by the manufacturer, for example).

Claim 2 has been amended to correct a typographical error which resulted in an additional period in the claim. Further, claims 29-31 have been added. Support for these claims can be found throughout the specification and claims as originally filed. See e.g., Examples 1-3 and claims 1, 11, 16, and 24 as originally filed. Accordingly, no new matter has been added.

II. Rejection under 35 U.S.C. §102(e)

Claims 1, 2, 6, 9, 10, 12, 13, 15, 16, 22, 23, 27, and 28 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,248,339 ("*Knitowski*") for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

Specifically, Applicants disagree with the Examiner's statement that "*Knitowski* clearly discloses butylene-ethylene-styrene copolymer, which is the same as the elected species," *i.e.*, styrene-butylene-ethylene-styrene. Butylene-ethylene-styrene copolymers are not triblock copolymers as they are merely composed of one soft segment (butylene-ethylene) and one hard segment (styrene). In contrast, styrene-butylene-ethylene-styrene is a triblock copolymer, *i.e.*, it comprises one hard segment (styrene), one soft segment (butylene-ethylene, and another hard segment (styrene). Accordingly, Applicants maintain that *Knitowski* fails to teach each and every element of the present claims, and therefore does not anticipate the present claims.

For at least the foregoing reason, Applicants respectfully request withdrawal of this rejection.

III. Claim Objection

Claim 2 has been objected to because the claims contained multiple periods. See page 3 of the present Office Action. Claim 2 has been amended herein, thereby rendering this objection moot.

IV. Rejection under 35 U.S.C. §102(b)

Claims 1, 6-10, 16, 22-24, and 27-28 have been rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,221,534 ("*DesLauriers*") for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

A rejection under § 102 is only proper when the claimed subject matter, in this case a composition, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

With respect to the rejection of claims 1, 6-10, 16, and 22-24, claim 1, as amended, is drawn to a composition comprising at least one linear dimethicone and at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, with the proviso that said composition comprises at least one tri-block copolymer

film former, and wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition. The Examiner points to *DesLauriers'* compositions in Tables 11 and 17. However, *DesLauriers'* composition in Table 17 does not comprise, at least, at least one linear dimethicone. Further, *DesLauriers'* compositions in Table 11 comprise at least 2.5% by weight of at least one block copolymer. More specifically, these compositions comprise at least 50 wt% Drakeol 5, which is a composition comprising a total of 5 wt% block copolymers. Thus, the Table 11 compositions comprise at least 2.5 wt% block copolymers (0.05 x 50 wt%). Nowhere else does *DesLauriers* disclose dimethicone. Accordingly, *DesLaurier* fails to identically describe or disclose the subject matter of claim 1.

New claim 29 is drawn to a composition comprising at least one linear dimethicone, at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, and at least one cyclic dimethicone, with the proviso that said composition comprises at least one tri-block copolymer film former.

DesLauriers does not identically describe or disclose the subject matter of this claim.

Applicants note that the Examiner asserts that "[t]he resulting gels are mixed with dimethicone and cyclomethicone," citing Tables 11 and 17. See page 4 of the present Office Action (emphasis). However, as discussed above, *DesLauriers'* composition in Table 17 comprises cyclomethicone but does not comprise at least

one linear dimethicone. Further, Table 11 of *DesLauriers* discloses compositions comprising dimethicone or cyclomethicone. Thus, *DesLauriers* fails to identically describe or disclose the subject matter of new claim 29.

Similarly, *DesLauriers* fails to identically describe or disclose the subject matter of new claim 31. This claim is drawn to a composition comprising, inter alia, at least one linear dimethicone in an amount ranging from 25% to 75%. Although Table 11 discloses a composition comprising 2 wt% dimethicone, *DesLauriers* fails to disclose the presently claimed composition.

With respect to the rejection of independent claims 27 and 28, the Examiner has contrived his § 102(b) rejection by picking, choosing and combining various disclosures in *DesLauriers*. Claims 27 and 28 disclose a composition comprising, inter alia, at least one linear dimethicone, at least one block copolymer film former, and at least one cosmetic powder, and a method of using the same. The Examiner asserts that *DesLauriers* discloses "KRATON triblock copolymers" and that "[t]he resulting gels are mixed with dimethicone...[and] are used in cosmetics such as mascara and blush, which contain powders (see col. 7, lines 4-53)." See page 4 of the present Office Action.

It is well known that, in order to identically describe or disclose the claimed composition, the reference must direct those skilled in the art to the composition without any need for picking, choosing, and combining various disclosures in the

reference not directly related to each other by the teachings of the cited reference.

See *In re Arkley*, at 587.

Thus, the Examiner, directly contravening that principle of anticipation law, picks the sole recitation of dimethicone in one portion of the disclosure (at col. 13, in Table 11), chooses other, unrelated, portions of the disclosure, including recitations of mascara (at col. 11, line 31, discussing utility of soft gels) and of blushers (at col. 11, line 40, discussing the utility of hard gels), and lists of optional ingredients such as that at col. 7, lines 7-10, each of which are separated from the single instance where dimethicone is disclosed by many pages, and combines those unrelated portions to form his § 102(b) rejection.

As this § 102(b) rejection relies on picking, choosing and combining various disclosures in *DesLauriers* not directly related to each other by the teachings of this reference, Applicants submit that it is improper. Applicants therefore maintain that *DesLauriers* does not anticipate claims 27 and 28 for at least the foregoing reasons.

New claim 30 discloses a composition comprising at least one linear dimethicone, at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, and at least one additional film former, with the proviso that said composition comprises at least one tri-block copolymer film former. As with the subject matter of claims 27 and 28, *DesLauriers* does not identically describe or disclose the claimed composition without any need for picking, choosing, and

combining various disclosures in the reference not directly related to each other by the teachings of the cited reference. Applicants therefore submit that *DesLauriers* does not anticipate new claim 30 for at least this reason.

For at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection over claims 1, 6-10, 16, 22-24, and 27-28.

V. Rejection under 35 U.S.C. §103(a)

Claims 1-2 and 4-28 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *DesLauriers* in view of U.S. Patent No. 6,066,313 ("*Anton*"), U.S. Patent No. 6,060,072 ("*Konik*"), or U.S. Patent No. 4,528,390 ("*Kimura*") for the reasons set forth at pages 4-5 of the present Office Action. Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The Examiner asserts that *DesLauriers* teaches "a gel made from mineral oil and blends of di- and triblock copolymers" which "are mixed with dimethicone and

cyclomethicone." See page 4 of the present Office Action (citing Tables 11 and 17). The Examiner then states that *DesLauriers* "lacks particular species of silicones," and therefore relies on *Anton* for the teaching of specific dimethicones, *Konik* for the teaching of specific film forming agents, and *Kimura* for the teaching of polymethylsilsesquioxanes.

With respect to the subject matter of claim 1, the requisite demonstration that the cited reference teach or suggest all the claim limitations has not been satisfied. For example, as discussed above, *DesLauriers* does not teach or suggest a composition according to claim 1, that is, a composition comprising at least one linear dimethicone and at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, with the proviso that said composition comprises at least one tri-block copolymer film former, and wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition.

As with the rejection under § 102(b), the Examiner points to *DesLauriers*' compositions in Tables 11 and 17. However, as discussed above, *DesLauriers*' composition in Table 17 does not comprise at least one linear dimethicone and the compositions in Table 11 comprise at least 2.5% by weight of at least one block copolymer. Moreover, the only composition comprising dimethicone and at least one block copolymer that did not exhibit separation comprised 2 wt% dimethicone

and 98% of a Drakeol 5 composition which comprised a total of 5 wt% Kraton copolymers. Thus, this composition comprised 4.9 wt% of the Kraton copolymers ($98\% \times 0.05 = 4.9\%$). If the concentration of the dimethicone was increased, and the concentration of the Drakeol 5 composition comprising the block copolymers therefore decreased, separation of the sample occurred. Further, as calculated above, *DesLauriers* did not even test compositions comprising less than 2.5 wt% block copolymers. Accordingly, based on the teachings of *DesLauriers*, one of ordinary skill in the art would not have been motivated to decrease the concentration of the at least one block copolymer to an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition.

As the cited references do not remedy the deficiencies of *DesLauriers*, the combination proposed by the Examiner fails to teach or suggest the subject matter of claims 1, 2, and 4-26.

With respect to new claim 29, wherein the composition comprises, inter alia, at least one linear dimethicone and at least one cyclic dimethicone, Applicants submit that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner to arrive at such a composition. As previously discussed, *DesLauriers* only discloses a composition comprising dimethicone in Table 11. This table compares the compatibility of gels with various components. However, *DesLauriers* does not suggest combining the tested components, such as cyclomethicone and dimethicone. In fact, of the emollients

tested, cyclomethicone and dimethicone were the worst. Accordingly, Applicants submit that one of ordinary skill in the art would not have been motivated to combine these two components, at least because they are disclosed to be the worst emollients in terms of sample separation.

For at least this reason, Applicants submit that neither *DesLauriers* alone or in combination with the cited secondary references render obvious the subject matter of claim 29.

Similarly, one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner necessary to arrive at the compositions of new claim 31. For example, the compositions of claim 31 comprise, inter alia, at least one linear dimethicone in an amount ranging from 25% to 75% by weight relative to the total weight of the composition.

It is well-known that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be . . . led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). In the present case, a person of ordinary skill would be led in a direction divergent from adding more than 2 wt% dimethicone to the compositions of *DesLauriers*, since as described above, *DesLauriers* teaches in its sole disclosure of dimethicone that compositions comprising greater than 2 wt% dimethicone result in sample separation. See Table 11.

For at least the foregoing reason, Applicants submit that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner necessary to arrive at the compositions of new claim 31.

With respect to the rejection of independent claims 27 and 28, the Examiner again asserts that *DesLauriers* discloses "KRATON triblock copolymers" and that "[t]he resulting gels are mixed with dimethicone...[and] are used in cosmetics such as mascara and blush, which contain powders (see col. 7, lines 4-53)." See page 4 of the present Office Action.

Thus, the Examiner's rejection is based on piecing together unrelated bits and pieces of *DesLauriers*' disclosure, combining them, and proclaiming the resulting "composition" obvious. However, the Examiner fails to provide any motivation for piecing together these bits and pieces.

The Federal Circuit recently reaffirmed the Examiner's high burden to establish a prima facie case of obviousness and emphasized the requirement for specificity. In *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally

available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added). Even when obviousness is based on a single prior art reference, there must be such a showing, based on objective evidence of record, to make the specific combination that was made by the applicant. See e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000); see also B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996).

In the present case, Applicant submit that the requisite objective teaching is not present in *DesLauriers*. For example, *DesLauriers* recites many uses of the gels disclosed therein, including for formation of soft gels (col. 7, lines 30-37) and for formation of hard gels (col. 7, lines 38-45). The disclosure of the numerous and various potential uses include utility "in waterproofing sunscreen compositions, makeup, mascara, etc.," and "as a matrix for clear or opaque stick products including deodorants, lipsticks, analgesics, blushers, solid lotions and solid fragrances." See col. 7, lines 30-31 and lines 39-41. None of these recitations include any mention of at least one linear dimethicone nor of at least one cosmetic powder. In fact, *DesLauriers* mentions dimethicone only once - in Table 11 - and this Table shows that it is the worst of the emollients tested in terms of sample separation. Accordingly, Applicants submit that the Examiner has failed to provide any motivation for piecing together these bits and therefore has failed to establish a prima facie case of obviousness

As claim 30 is drawn to a composition comprising at least one linear dimethicone, at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, and at least one additional film former, with the proviso that said composition comprises at least one tri-block copolymer film former, Applicants submit that, for at least the reasons discussed above with respect to claims 27 and 28, one of ordinary skill in the art would not have had the requisite motivation to pick and choose bits and pieces of *DesLauriers'* compositions in a manner necessary to arrive at a composition according to claim 30.

For at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection over claims 1-2 and 4-28.

VI. Obviousness-type Double Patenting Rejection

Claims 1-2 and 4-28 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 6-7, 16, and 24 of copending Application No. 09/258,809 for the reasons set forth on page 6 of the present Office Action.

Although Applicants disagree with this rejection, they submit herewith a Terminal Disclaimer to render the rejection moot. Accordingly, Applicants respectfully request the withdrawal of this rejection.

VII. Information Disclosure Statement

Applicants note that in the initialed Information Disclosure Statement attached to the present Office Action, PTO Paper No. 6, the Examiner drew a line through the entry reciting "Abstract 114: 108 976, XP002143304, "Film-forming Aerosol Preparations Containing ABA-type Triblock Thermoplastic Elastomers," and added "No Date" beside this listing. However, Applicants draw the Examiner's attention to the abstract, in particular to the underlined headings entitled "Date." Accordingly, Applicants respectfully request that the Examiner initial the PTO Form 1449 beside the recitation of this Abstract and provide Applicants with a copy of the initialed document once it has been considered by the Examiner.

VIII. Conclusion

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extension of time under 37 C.F.R. § 1.136 required to enter this response and charge those additional fees to our Deposit Account No. 06-916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Thalia V. Wainwright, Reg. No. 39,064
By: *for Anthony C. Fridico*
Anthony C. Fridico
Reg. No. 45,958

Dated: October 30, 2002

Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § .121(c)(1)(ii):

IN THE SPECIFICATION:

Please substitute the following paragraph for the original paragraph at page 9, last paragraph as follows:

--In one embodiment, the concentration of at least one block copolymer film former ranges from 0.139% to 4.185% [1% to 30%] by weight, such as from 0.265% to 1.953% [1.9% to 14%] by weight. The concentrations as used herein refer to the concentration of active ingredients.--

IN THE CLAIMS

--1. (Twice Amended) A composition comprising:

at least one linear dimethicone; and

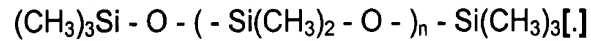
at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, with the proviso that said composition comprises at least one tri-block copolymer film former,

wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

-- 2. (Amended) The composition according to claim 1, wherein said at least one linear dimethicone is chosen from linear polydimethylsiloxanes of the formula



wherein n ranges from 0 to 7.

10. (Amended) The composition according to claim 1, wherein said at least one block copolymer film former is present in said composition in an amount ranging from **0.139% to 4.185%** [1% to 30%] by weight.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com